

3729

TS01-325

Application no. 09/933,961



August 26, 2003

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Art Unit 3729 - Examiner Rick Kiltae Chang

FROM: George O. Saile, Reg. No. 19,572  
28 Davis Avenue  
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 09/933,961  
File Date: 08/22/01  
Inventor: Yun-Hung Shen  
Examiner: Rick Kiltae Chang  
Art Unit: 3729  
Title: Electrostatic Discharge-Free Container for Insulating Articles

### RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated August 7, 2003. In that office action, restriction was required to one of the following Inventions under

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on August 27, 2003.

Signature   
Stephen B. Ackerman, Reg. No. 37,761

Date: 8/27/03

35 U.S.C. 121:

The inventions stated are:

I - Claims 1-3 and 7-12, drawn to a product, classified in class 361, and

II - Claims 4-6 and 13-18, drawn to a method, classified in class 29.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group II - Claims 4-6 and 13-18, drawn to a process classified in Class 29. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of "creating a component container for storing and transporting components", and that the product claims are directed to "a component container for storing and transporting

components", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class 29 and product class 361, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "the product as claimed can be made by another and materially different process such as one that first provides a metallic layer before providing an inner shell and attaching the inner shell to the metallic layer" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

  
Stephen B. Ackerman, Reg. No. 37,761